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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/709,900

11/10/2000

John J. Gabrick

MINMAT.P01

3638

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THE LAW OFFICE OF RICHARD W. JAMES
25 CHURCHILL ROAD
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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT

PAPER NUMBER

3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/709,900

Applicant(s)

GABRICK ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-18 and 20-57 is/are pending in the application.
- 4a) Of the above claim(s) 20-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/25/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. This action is in response to the amendment filed on December 5, 2006. Claims 8-18 and 20-57 are pending. Claims 1-7 and 19 are canceled. Claims 8-18 are examined, and claims 20-57 are withdrawn from consideration. Claim 8 is currently amended.

Response to Arguments

2. Applicant's arguments filed December 5, 2006 have been fully considered but they are not persuasive.

In response to the applicant's argument that Asplen (US 6,044,354) fails to teach matching an innovation and innovator with a developer as claimed in claim 8, examiner respectfully disagrees. Asplen teaches a new idea is submitted and to be evaluated according to certain criterion as determined by the organization, and the result of the decision (i.e. discarding, put on hold, or pass the idea) will be sent to the person who submitted the idea (column 3 lines 10-27). The new idea in Asplen's teaching corresponds to the innovation, the evaluation criteria by the organization corresponds to the innovator with a developer, and the result of the decision sent to the submitter corresponds to the match outcome.

Regarding the double patenting rejection with co-pending application 09/687,510, although claims 1-11 of 09/687,510 are canceled, the conflicted claims 12-16 of 09/687,510 are still applied.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asplen, Jr., U. S. Patent 6,044,354 in view of Ziff et al., U. S. Patent 6,557,013.

As to claim 8, Asplen teaches a system for development of IP, the system comprising software to be run on a computer, the software comprising (abstract and Fig. 1A):

- a) An innovator attraction module (column 2 lines 45-52 and Fig. 1A);
- b) A developer attraction module (column 2 line 64 – column 3 line 35 and Fig. 1A);
- c) A registration module (column 2 lines 49-58 and Fig. 1A);
- d) A match module (column 3 lines 10-27 and Fig. 1A);

the registration module to accept data related to an innovator and the innovator's innovation and to store the data in an innovation database (column 2 lines 49-60 and Figs. 1 and 1A), and the match module to match the innovation and the innovator with a developer (column 2 line 59 – column 3 lines 9 and Fig. 1A).

Asplen does not specifically teach the system is a web-based development. However, Asplen teaches the system uses LAN, WAN, Internet, and emails (column 2 lines 2-14), and Ziff teaches using web-based system for developing writing assignment

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(Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the system in Asplen's teaching to be a web-based development since the Asplen's already use the internet for developing innovated ideas; in addition, by enhancing the system with the web-based technology, it would allow the innovated ideas to be fast and easily processed.

As to claim 9, Asplen teaches the innovation database is operably stored for random retrieval on a storage medium (column 2 lines 49-60 and Figs. 1 and 1A).

As to claim 10, Asplen teaches updating and changes to the data are also stored in the innovation database (column 6 lines 15-18).

As to claim 11, Asplen teaches the match module is to match one or more other innovations with one or more other developers (column 2 line 45 – column 3 line 35 and Figs. 1 and 1A).

As to claim 12-18, Asplen teaches a tracking module to make available to a user at least one of a status and an outcome of any activity related to the matching of the innovation and the innovator with the developer (column 2 lines 2-14 and column 3 lines 18-35 and column 5 lines 54-67 and Figs. 1 and 1A).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 8-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-16 of copending Application No. 09/687,510. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose a system for web based development of intellectual property.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquire

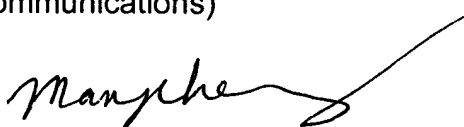
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300 (Official Communications; including After Final
Communications labeled "BOX AF")
(571) 273-6705 (Draft Communications)

Mary Cheung
February 26, 2007


MARY D. CHEUNG
PRIMARY EXAMINER